

REMARKS

Claims 1-32 are pending. Claims 10, 12, and 13 stand objected to as having informalities. Claim 25 stands objected to as being of improper dependent form. Claim 9 stands rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1-32 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,047,300 to Walfish et al.

Reconsideration is requested. No new matter is added. The specification is amended. Claims 1, 5-6, 8, 10-13, 17, 22-23, and 25 are amended. Claims 2-4, 9, 18-21, 24, 29, and 31-32 are canceled. Claims 33-36 are added. The rejections are traversed. Claims 1, 5-8, 10-17, 22-23, 25-28, 30, and 33-36 remain in the case for consideration.

OBJECTION OF CLAIMS AS HAVING INFORMALITIES

The Examiner objected to claim 10 as not accurately describing the invention because claim 10 calls for alternative corrections to be entered by the user, but claim 1, from which claim 10 depends, recites that the update of the static list is done by the computer. But claim 10 does accurately define the invention. As described in the cited portion of the specification, the user selects among the alternative corrected spellings for the misspelled word. The computer then updates the static update list to correct the misspelled word with the alternative corrected spelling of the misspelled word.

In other words, the computer finds multiple correct spellings of the misspelled word. The computer does not pick for the user the correct spelling, but lets the user decide. Then, once the computer knows the user's choice, the computer updates the static update list with the user's choice. Thus, the method of claim 10 describes a method that can be carried out completely by the computer, and claim 10 accurately describes the invention.

The Examiner objected to claims 10 and 12 because he thought the indefinite article "an" should be replaced with "the" with reference to the "alternate correctly spelled word," and that the definite article "the" should be replaced with "an alternate" in line 3 of the claims. In rejecting the Applicant's arguments, the Examiner points to the use of the phrase "correctly spelled words" in claim 1 and to portions of the specification.

The Applicant acknowledges that there can be some confusion about which of the "alternate correctly spelled word" and the "correctly spelled word" would be in the static update list. Nevertheless, the Applicant believes the claim is correct as worded. In claim 1, a "misspelled word" and a "corrected spelling of the misspelled word" have been identified.

Because claim 1 describes “updating the static update list of pairs of misspelled and correctly spelled words by the computer to include the misspelled word and the corrected spelling of the misspelled word”, of necessity, the static update list does not currently include this particular pair. Thus, if the misspelled word is currently in the static update list, it must be associated with some other correct spelling. This “other correct spelling” is the “alternate correctly spelled word for the misspelled word” mentioned in claim 10. Claim 10 describes changing the association of the misspelled word from the “alternate correctly spelled word for the misspelled word” to the “corrected spelling of the misspelled word”. This is consistent with the description in the specification, even though the specification described the “alternate” word being added to the specification: in both claim 10 and the specification, a correct spelling not in the static update list is replacing a word that is currently found in the static update list. Claims 12 and 13, for similar reasons, are correct as written.

The Examiner’s proposed amendment to claim 10 is therefore not the appropriate amendment. Proposed claim 10 reads as though it would remove from the static update list a pair that does not currently exist in the static update list in favor of a pair that is already present in the static update list. Note that claim 1 describes updating the static update list to include the misspelled word and the corrected spelling of the misspelled word. Clearly, this pair is not already in the static update list, and so the “correctly spelled word” cannot be replaced with something else.

The Examiner is again pointed to the example in the specification at FIG. 7 and the accompanying description at page 6, lines 10-19. In the indicated portion of the specification, the misspelled word is “theri,” and the spelling currently in the static list is “their.” Note that “their” is a valid word. But assume that the user prefers that “there” be the automatic correction of “theri”: that is, whenever the user types “theri” by mistake, the user wants the word “there” put in the place of “theri” automatically. Thus, “their” is the alternate correctly spelled word, being replaced by the correctly spelled word “there.” This is what is claimed in claims 10, 12, and 13.

The Examiner objected to claim 25 as failing to further limit the subject matter of the previous claim. The Examiner argues that a counter inherently includes an incrementer. This argument is false. A “count” is a number stored somewhere (e.g., in memory). Numbers do not change their values on their own: something else has to act on the number to change its value. This is precisely what an incrementer does.

The prior art cited by the Examiner is pertinent to this point. In the Office Action dated December 15, 2003, the Examiner had cited U.S. Patent No. 5,875,443 to Nielsen.

While not currently cited by the Examiner against any of the claims, at column 4, lines 20-31, Nielsen describes the third database as storing “words . . . that have been requested by users . . . , together with the number [i.e., a counter] of times that each word in this database has been requested. . . . If [the word requested to be added] already exists in this database, then the number of request instances for the word is increased [i.e., incremented] by one.” Thus, claim 25 further limits the subject matter of the claim, and requires neither cancellation nor amendment.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102(e)

To begin with, several claims have been amended to clarify terms that might be considered unclear. The most obvious example of this is the term “correctly spelled word”, which had been used, for example, in claim 5. Because claim 1 had used the term “corrected spelling of the misspelled word”, this term has been used in place of terms such as “correctly spelled word” to make clear the intended meaning of the claims. These amendments are not to make the claims allowable: the Examiner has not given a rejection that these other terms were ambiguous. The Applicant submits these amendments simply to introduce consistency into the claims.

In rejecting the claims, the Examiner has relied on some teachings of Walfish that are, at best, implicit. The first of these is the concept of the count, which has been moved from claim 3 into claim 1, from claim 20 into claim 11, from claim 24 into claim 23, and from claim 29 into claim 28. All of independent claims 1, 11, 23, and 28 therefore now claim the use of a count of the number of times the misspelled word has been parsed and the corrected spelling received.

Nowhere does Walfish teach or disclose the concept of a counter in any form. The Examiner has argued that Walfish does teach this feature: for example, in rejecting claim 3, the Examiner argues that the “corrected word pair is added to the AutoCorrect List when the count reaches one” (*see* Office Action dated May 3, 2004, page 6, lines 12-13).

The Examiner is reading between the lines. Starting at column 13, line 60, Walfish discloses that “[o]nce a misspelled word is replaced with a replacement word, a corrected word pair including the misspelled word and the correctly spelled replacement word is automatically added to the AutoCorrect List.” In other words, the update of the AutoCorrect List happens immediately.

The Examiner has argued that because Walfish requires encountering the misspelled word and the replacement word at least once, Walfish must be counting the number of times

the misspelled word and the replacement word are encountered. (Obviously, Walfish cannot teach an update to the AutoCorrect List without knowing the pair of words to add.) But nowhere does Walfish teach or suggest that the AutoCorrect List would be updated only after encountering the word pair more than once. This concept would require tracking information that Walfish does not mention or even hint at. Thus, at best, Walfish implicitly counts to one, and nowhere does Walfish store a count. Thus, claims 23, 25-28, 30, and 35-36 all of which are apparatus or data structure claims and include the feature of a counter, are allowable under 35 U.S.C. § 102(e) over Walfish. Further, a rejection under 35 U.S.C. § 102 requires the prior art to explicitly teach the features of the invention. As Walfish does not explicitly disclose a count, claims 1, 5-8, 10-17, 22, and 33-34 should all be allowable under 35 U.S.C. § 102(e) over Walfish.

In addition, to help emphasize distinguishing features, claims 1, 11, and 35-36 all describe the threshold being greater than one. Even if the Examiner were correct to read Walfish as implicitly disclosing a counter, Walfish cannot be read as teaching any threshold greater than one. Accordingly, because claims 1, 5-8, 10-17, 22-23, 25-28, 30, and 33-36 all disclose a threshold greater than one, claims 1, 5-8, 10-17, 22, and 35-36 should now all be allowable under 35 U.S.C. § 102(e) over Walfish.

The Applicant wants to make a special point with regard to claims 1, 11, 23, 33, and 34. All of these claims describe the count as indicating the number of times the misspelled word has been parsed and the corrected spelling of the word received. The use of the conjunction “and” in this clause is significant. The counts represent the number of times both events have occurred: that is, the misspelled word was parsed as misspelled, and the corrected spelling was received. The count is not, for example, the number of times these two events have happened individually. For example, dynamic update list 545 of FIG. 8 of the application shows two different pairs, both associated with the correctly spelled word “available”. Each of these pairs has its own count. Thus, “avaialble” has been corrected to “available” 3 times, and “availabel” has been corrected to “available” 6 times. These counts do not mean that “avaialble” and “available” have been encountered 3 times, and that “availabel” and “available” have been encountered 6 times. Encountering either misspelling by themselves, or encountering a correct spelling of “available” by itself, is not enough to trigger a change in either counter.

Another general point worth noting is the general operation of the invention versus the general operation of Walfish. Walfish is assigned to Microsoft Corporation, the distributor of Microsoft Word, which uses an AutoCorrect List. Despite the fact that the

Walfish patent was originally filed more than 7 years ago, Walfish has never been implemented as an improvement to the AutoCorrect List feature of Microsoft Word. Why is that? The reason probably lies in the fact that the AutoCorrect List is not designed to store every possible combination of misspelled words and correctly spelled words. First, if the AutoCorrect List included every such possible pair, it is very likely that some pairs would include the same misspelled word, creating a conflict in attempting to correct the misspelling. Second, and perhaps more important, the AutoCorrect List is not the fastest way to implement spell checking. It is designed to be a list of the most frequent errors and corrections. Because Walfish would import into the AutoCorrect List every pair of misspelled and corrected words, Walfish would result render the AutoCorrect List relatively useless very quickly.

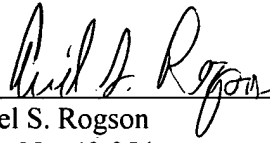
In contrast, the invention is *not* designed to add every possible pair of misspelled words and correctly spelled words to the static update list. Instead, the impetus of the invention was to find a way to learn the user's individual typing errors. The invention then adds to the static update list (that is, the AutoCorrect List of Walfish) only those pairs of misspelled words and correctly spelled words that the user repeatedly inputs. Not every misspelled word will end up in the static update list: only those words that the user misspells on a repeated basis. This automatically customizes the static update list to the user's typing style without turning the static update list into a list of every possible misspelled word and correction. But the latter is exactly what Walfish does, and therein lies the difference between Walfish and the invention.

For the reasons stated above, Walfish does not teach all of the features of the claimed invention. Accordingly, claims 1, 5-8, 10-17, 22-23, 25-28, 30, and 33-36 are allowable under 35 U.S.C. § 102(e) over Walfish.

For the foregoing reasons, reconsideration and allowance of claims 1, 5-8, 10-17, 22-23, 25-28, 30, and 33-36 of the application as amended is solicited. **The Examiner is requested to telephone the undersigned at (503) 222-3613 to schedule an interview, at the very least to discuss the objections to claims 10, 12-13, and 25, and preferably to discuss the arguments with respect to the rejection of the claims over Walfish.**

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.



Ariel S. Rogson
Reg. No. 43,054

MARGER JOHNSON & McCOLLOM, P.C.
1030 SW Morrison Street
Portland, OR 97205
503-222-3613
Customer No. 20575

I HEREBY CERTIFY THAT
THIS CORRESPONDENCE IS
BEING DEPOSITED WITH THE
UNITED STATES POSTAL
SERVICE AS FIRST CLASS
MAIL IN AN ENVELOPE
ADDRESSED TO:

☐ COMMISSIONER OF PATENTS
AND TRADEMARKS WASHINGTON
D.C. 20231

☒ MAIL STOP *Amendment*
COMMISSIONER FOR PATENTS
BOX 1450
ALEXANDRIA, VA 22313-1450

☐ BOX _____
COMMISSIONER
FOR TRADEMARKS 2900 CRYSTAL
DRIVE ARLINGTON, VA 22202-3513

ON: *11 OCT 2004*
Ariel S. Rogson